

Reply Under 37 C.F.R. § 1.116  
Expedited Procedure  
Technology Center 2800

Application No.: 10/550,493  
Art Unit: 2876

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. In the claims

As shown in the foregoing LIST OF CURRENT CLAIMS, the claims have been amended to more clearly point out the subject matter for which protection is sought.

Claim 1 is amended to incorporate the features of previously presented dependent claim 2, and to include the recitation of a self-adhesive covering element. It is respectfully submitted that no new matter is added, sine the change merely merges the subject matter of previously presented claims and since support for the amendment may be found, for example, at least in Figs. 2, 5, and 6 of the pending application and at least in paragraph [0013] of the accompanying description in the specification as originally filed.

Claim 2 is canceled and the subject matter thereof is added to amended claim 1.

Claim 11 is amended to incorporate the features of previously presented dependent claim 14. It is respectfully submitted that no new matter is added, sine the change merely merges the subject matter of previously presented claims.

Claim 14 is canceled and the subject matter thereof is added to amended claim 11.

Claims 3, 4, 6-10, 12, 13, and 15-18 are left unchanged.

Claim 5 remains canceled.

Entry of the LIST OF CURRENT CLAIMS is respectfully requested in the next Office communication.

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2. Rejection of claims 1-3, 9, 11, 13, 14, and 16-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 7,168,623 (*Royer*) in view of U.S. patent no. 5,528,222 (*Moskowitz et al.*) and further in view of International publication no. WO 93/22146 (*Trapletti*)

Reconsideration of this rejection is respectfully requested, in view of the amendments to claims 1 and 11, on the basis that the proposed combination of the *Royer* and *Moskowitz* patents and the *Trapletti* publication fails to establish a *prima facie* case of obviousness with respect to amended claims 1 and 11. The remaining claims depend from either claim 1 or 11, and are therefore patentable as containing all of the recited steps or elements of claims 1 or 11, as well as for their respective recited features.

The arguments with respect to the proposed combination of the *Royer* and *Moskowitz* patents and the *Trapletti* publication that were presented in the response filed February 5, 2009, are incorporated herein in their entirety by reference.

In particular, it is respectfully reiterated that none of the disclosures of the *Royer* and *Moskowitz* patents or the *Trapletti* publication appreciate or discuss the problem that an intaglio printing process used with the self-adhesive electronic circuit of the *Royer* patent is likely to destroy the chip 12 of the self-adhesive electronic circuit of the *Royer* patent due to the pressures involved in the intaglio printing process. Thus, there is no disclosure or suggestion in the *Royer* and *Moskowitz* patents or the *Trapletti* publication to incorporate the chip 12 of the self-adhesive electronic circuit of the *Royer* patent following an intaglio printing process to print an area on the self-adhesive electronic circuit of the *Royer* patent.

The Office action notes on page 15 that it is considered to be well known to print on a substrate of a label prior to or after attaching a transponder to an RFID label, as evidenced by the disclosures of U.S. patent no. 6,019,865 (*Palmer*), U.S. patent no. 6,280,544 (*Fox et al.*), and U.S. patent no. 6,857,714 (*Hohberger et al.*).

However, none of the *Palmer*, *Fox*, or *Hohberger* patents contemplates the use of an intaglio printing process, which process can destroy a transponder or chip due to the pressures involved in the intaglio printing process.

In particular, each of the *Palmer*, *Fox*, and *Hohberger* patents discuss thermal printers, and only the *Fox* patent recognizes that a problem with applying the RFID transponder to the label prior to printing is that due to uneven thicknesses of the label in the vicinity of the attached transponder, the print area may be decreased (*Fox*, col. 2, lines 1-13), while each of the *Palmer* and *Hohberger* patents do not indicate such a problem, and in fact the *Palmer* and *Hohberger* patents indicate that thermal printing of labels having pre-attached RFID transponders is known (*Hohberger*, col. 2, lines 49-51), and is preferred (*Palmer*, col. 1, lines 63-65).

In view of the preference in the prior art to print labels already having RFID transponders attached thereto, and since the thermal printing disclosed in the prior art does not have the same issue of destroying an RFID transponder or chip as is encountered in an intaglio printing process, and further since the problem of uneven thickness of the label in the area of the RFID transponder is not an issue for the self-adhesive electronic circuit of the *Royer* patent since the chip 12 is retained within a slot 21 of the double faced adhesive (*Royer*, col. 2, lines 41-52), a person having ordinary skill in the art would not have determined from the teachings of the *Royer* and *Moskowitz* patents and the *Trapletti* publication, or the *Palmer*, *Fox*, and *Hohberger* patents, to utilize an intaglio printing process to print security features prior to providing the chip 12 into the slot 21 of the *Royer* patent, as is required by amended claims 1 and 11.

Further, amended claims 1 and 11 require the recess with the integrated circuit to be closed with a self-adhesive covering element.

This feature allows the integrated circuit to be incorporated into the security label after the actual production process of the security label, in contrast to the complex production facilities required to, for example, mold the chip into the

substrate (as disclosed in the *Royer* patent). This feature also provides a suitable security label that can be used, for example, as a sticker for a VISA, wherein the security label is personalized via intaglio printing by an authority. In this case, the chip can also be incorporated into the security element after the intaglio printing and can be secured with the self-adhesive covering foil, if required, manually. It is respectfully submitted that the molding of the chip according to the *Royer* patent does not offer these same advantages.

Further, when the integrated circuit recited in amended claims 1 and 11 is covered with a self-adhesive covering element, the connection between the integrated circuit and the antenna is reliably damaged when it is attempted to pull the security element off of an object to which it has been adhered (paragraphs [0013] and [0022] of the specification as originally filed). This is further exemplified by the illustration in Fig. 5 of the pending application, where it is shown that the integrated circuit is connected to the antenna 32, but not to the substrate 40, and the connection between the integrated circuit and the antenna 32 can be reliably damaged only if the covering element 38 is a self-adhesive covering element, such that when the security label is pulled from the object to which it is attached, the self-adhesive covering element will have a tendency to remain attached to the object, and the integrated circuit will have a tendency to remain attached to the self-adhesive covering element, while the substrate and the antenna will be pulled away and separated from the integrated circuit.

Turning to the resin drop 19, 22 of the *Royer* patent, which the Office action has identified on page 6 as a covering element, there is simply no disclosure or suggestion that the resin drop 19, 22 is formed as a self-adhesive covering element, as is required by amended claims 1 and 11.

In particular, while the Office action indicates on page 6 that such a resin in the *Royer* patent is well known to be also called a self-adhesive resin, the Office action provides no substantiation for this statement. In fact, it is respectfully submitted that resins, while possibly tacky in the liquid state (col. 3, lines 25-27) in

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which the resin of the *Royer* patent is applied, are well known to subsequently solidify and lose any such tackiness.

This is further evidenced in the *Royer* patent in the figures where it is shown that a release layer (strippable sheet 24) covers the surface of the double faced adhesive 20, but no such release layer is deemed necessary to cover the resin drop 19, 22.

Additionally, as shown in Figs. 2, 4, 8, and 9, the resin drop 19, 22 has a surface area that is provided lower than the surface area of the double faced adhesive 20, and is thus not contemplated to be used to contact and/or adhere the self-adhesive electronic circuit of the *Royer* patent to an object.

Thus, for the reasons discussed above, it is respectfully submitted that the proposed combination of the *Royer* and *Moskowitz* patents and the *Trapletti* publication fails to establish a *prima facie* case of obviousness with respect to amended claims 1 and 11, and withdrawal of this rejection is respectfully requested.

As mentioned above, applicants submit that independent claims 1 and 11 are patentable and therefore, claims 3, 9, 11, 13, and 16-18, which depend from claims 1 or 11 respectively, are also considered to be patentable as containing all of the steps or elements of claims 1 or 11, as well as for their respective recited features.

3. Rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 7,168,623 (*Royer*) in view of U.S. patent no. 5,528,222 (*Moskowitz et al.*) and in view of International publication no. WO 93/22146 (*Trapletti*) and further in view of “admissions of prior art by Bauer et al in the specification”

Reconsideration of this rejection is respectfully requested on the basis that the “admissions of prior art by Bauer et al in the specification” fails to provide for the deficiencies of the proposed combination of the *Royer* and *Moskowitz* patents and the

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*Trapletti* publication, as discussed above in detail with respect to claim 1, from which claim 4 depends.

Accordingly, withdrawal of this rejection is respectfully requested.

4. Rejection of claims 6 and 7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 7,168,623 (*Royer*) in view of U.S. patent no. 5,528,222 (*Moskowitz et al.*) and in view of International publication no. WO 93/22146 (*Trapletti*) and further in view of U.S. patent no. 5,886,798 (*Staub et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Staub* patent fails to provide for the deficiencies of the proposed combination of the *Royer* and *Moskowitz* patents and the *Trapletti* publication, as discussed above in detail with respect to claim 1, from which claims 6 and 7 depend.

Accordingly, withdrawal of this rejection is respectfully requested.

5. Rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 7,168,623 (*Royer*) in view of U.S. patent no. 5,528,222 (*Moskowitz et al.*) and in view of International publication no. WO 93/22146 (*Trapletti*) and further in view of U.S. patent no. 6,830,192 (*Krul et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Krul* patent fails to provide for the deficiencies of the proposed combination of the *Royer* and *Moskowitz* patents and the *Trapletti* publication, as discussed above in detail with respect to claim 1, from which claim 8 depends.

Accordingly, withdrawal of this rejection is respectfully requested.

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6. Rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 7,168,623 (*Royer*) in view of U.S. patent no. 5,528,222 (*Moskowitz et al.*) and in view of International publication no. WO 93/22146 (*Trapletti*) and further in view of U.S. publication no. 2004/0157054 (*Rancien*)

Reconsideration of this rejection is respectfully requested on the basis that the *Rancien* publication fails to provide for the deficiencies of the proposed combination of the *Royer* and *Moskowitz* patents and the *Trapletti* publication, as discussed above in detail with respect to claim 1, from which claim 10 ultimately depends.

Accordingly, withdrawal of this rejection is respectfully requested.

7. Rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 7,168,623 (*Royer*) in view of U.S. patent no. 5,528,222 (*Moskowitz et al.*) and in view of International publication no. WO 93/22146 (*Trapletti*) and further in view of U.S. patent no. 5,763,058 (*Isen et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Isen* patent fails to provide for the deficiencies of the proposed combination of the *Royer* and *Moskowitz* patents and the *Trapletti* publication, as discussed above in detail with respect to claim 11, from which claim 12 depends.

Accordingly, withdrawal of this rejection is respectfully requested.

8. Rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 7,168,623 (*Royer*) in view of U.S. patent no. 5,528,222 (*Moskowitz et al.*) and in view of International publication no. WO 93/22146 (*Trapletti*) and further in view of U.S. patent no. 6,206,292 (*Robertz et al.*)

Reconsideration of this rejection is respectfully requested on the basis that the *Robertz* patent fails to provide for the deficiencies of the proposed combination of the *Royer* and *Moskowitz* patents and the *Trapletti* publication, as discussed above in detail with respect to claim 11, from which claim 15 depends.

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Accordingly, withdrawal of this rejection is respectfully requested.

9. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

Please charge any additional fees required or credit any overpayments in connection with this paper to Deposit Account No. 02-0200.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,  
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